

**REMARKS**

Claims 1-70 are pending in the application and are subject to requirement for restriction.

**RESTRICTION REQUIREMENT**

The Restriction Requirement requires restriction to one of the following inventions:

- I. Group I, Claims 1-33, 51, and 62-64 drawn to system or method for imaging the interior of a bodily cavity having first and second imaging means, both positionable within the interior, the second means positionable relative to the first, wherein the first image depicts the location of the second imaging means.
- II. Group II, Claims 34-50, 52-61 and 65-70, drawn to a system or method for mapping the interior of a bodily cavity comprising a position indication means variably positionable within, a position detection means for receiving a signal from the position indication means and a processor means that analyses said signal and provides output indicative of location of position indication means relative to position detection means.

The Examiner maintains that the groups of inventions are not so liked as to form a single general inventive concept under PCT Rule 13.1. According to the restriction requirement, the groups of inventions do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features. The Examiner considers that in the Group I invention, the first image depicting the location of the second imaging means comprises the first special technical feature, and in the Group II

invention, the second special technical feature comprises the processor means that analyzes the signal and provides output indicative of location of position indication means relative to position detection means. According to the Office Action, the two groups of claims do not share a special technical feature and they do not satisfy the requirement of unity of invention.

### **Election**

In order to be responsive to the requirement for restriction, Applicant elects Group I, i.e., Claims 1-33, 51, and 62-64 with traverse.

### **Traverse**

Notwithstanding the election of Group I in order to be responsive to the Restriction Requirement, Applicant respectfully traverses the requirement for restriction.

Applicant notes that this application is a national stage of PCT/AU03/01289, and thereby under unity of invention practice the Examiner must establish that the claims lack unity of invention under PCT Rule 13.1 and 37 C.F.R. 1.475.

In particular, the Examiner is reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. 1.475 must be considered. Specifically, Applicant notes that 37 C.F.R. 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

- (b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
  - (1) A product and a process specially adapted for the manufacture of said product; or
  - (2) A product and process of use of said product; or
  - (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
  - (4) A process and an apparatus or means specifically designed for carrying out the said process; or
  - (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.
- (c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.
- (d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).
- (e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Thus, in making the restriction requirement, the requirement must state why unity of invention is lacking under PCT rules, including 37 C.F.R. 1.475. In the instant situation, the lack of unity assertion only references 37 C.F.R. 1.475(a), in terms of advising that should applicant traverse on the grounds that the inventions have unity of invention applicant must provide reasons in support thereof in accordance with 37 C.F.R. 1.475(a). However, the lack of unity assertion does not make a showing under 37 C.F.R. 1.475(a). Thus, the restriction requirement improperly does not make any showing that there is not a technical relationship among the recited inventions involving one or more of the same or corresponding special technical features, with the expression "special technical features" meaning those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. The present specification at paragraph [0112] and FIG. 7, for example, show the

inventions of the two groups are so linked as to form a single general inventive, and show a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Therefore, because the Restriction Requirement has not complied with at least the required showing of 37 C.F.R. 1.475(a), the restriction requirement should be withdrawn. If the lack of unity assertion is maintained, the Patent and Trademark Office must include the appropriate showings that unity of invention is not present.

Respectfully Submitted,  
Ashish Dhar DIWAN

A handwritten signature in black ink, appearing to read "Barry I. Hollander", written over a horizontal line.

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August 30, 2010  
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